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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,707	04/14/2004	Yong Seo Cho	4472-042	5225
22429	7590	11/04/2005	EXAMINER	
LOWE HAUPTMAN GILMAN AND BERNER, LLP			SOLOLA, TAOFIQ A	
1700 DIAGONAL ROAD			ART UNIT	
SUITE 300 /310			PAPER NUMBER	
ALEXANDRIA, VA 22314			1626	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/823,707	Applicant(s) CHO ET AL.	
	Examiner Taofiq A. Solola	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 9-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 9-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: ____. |

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Claims 9-40 are pending in this application.

Claims 1-8 are cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 38-39 are drawn to a process wherein the yield of the product is at least 77 and 90 %, respectively. The term "at least" implies the yield could be as much as 100 %. According to the specification, examples 1-6, the yield is between 77 and 96 %. Therefore, the specification lacks adequate support for the yield as claimed. By limiting the yield to 77 and 96 % the rejection would be overcome. However, such would make the claims substantial duplicates of claim 25, which is drawn to the same process but without specifying the yield percentage.

Claim 40 is drawn to a process of making any Diels-Alder reaction product. The products are not identified in the specification. Therefore, the claim is not classifiable.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claims 14, 20, 33, 38-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For reasons set forth above under 35 USC 112, first paragraph, claims 38-39 are indefinite. Claim 40 is not classifiable as required under 35 USC 8 and therefore indefinite. See MPEP 903. The claims do not have identifiable product. Under 35 USC 8, MPEP 903, all claims must be classified. The class and subclass(es) must be searched to determine patentability. It is mandatory under the US patent practice that every allowed claim be classified. MPEP 904. In a claim drawn to a process of making, the product determines the classification. In the instant invention, the product is not identifiable: structurally or by any other means. While the statute may not require applicant to draft a claim in terms pertinent to the USPTO classification system, applicant should note that the Examiner needs not allow such a claim because the Office must perform its duty in conformance with 35 USC 8 and other relevant statutes. By deleting he claim the rejection would be overcome.

The term "phenyl" in claims 14, 20, 33 lacks proper antecedent basis in claim 9. While any of R1-R3 may form a ring adjacent substituents none in and of itself is defined a ring in claim 9. Appropriate correction is required.

Claim Rejections - 35 USC §§ 102, 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-40 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Korean Chem. Soc., Article "The 91" Nat. meeting of the Korean Chem. Soc. April 18-19, 2003, page 363.

Korean Chem. Soc., disclose a process of making seven and eight-membered ring compounds having bicyclic ethers comprising intermolecular Prins-type cyclization. See reaction scheme I 31P121, page 363.

On or about 9/21/05, the Examiner spoke with applicant's representative requesting the full paper of the above-cited article as well as the author(s). This application is now past due date and the article is not yet received. In response to this Office action, the article must be submitted at which time the Examiner would revisit the rejection. If the rejection is upheld, additional explanation may be required under the 35 USC 102 and/or 103 rejection. Such would be made final.

Foreign Priority

This application claims foreign priority but an English translation of the priority document is not yet received.

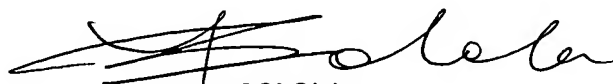
Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, J.D. whose telephone number is (571) 272-0709.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Taofiq Solola', with a stylized, sweeping flourish at the end.

TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1626

November 1, 2005